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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,301	04/02/2004	Susan Y. Davis	P001	1882

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EXAMINER

DAVIS, CASSANDRA HOPE

ART UNIT PAPER NUMBER

3611

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,301

Applicant(s)

DAVIS ET AL.

Examiner

Cassandra Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 15, 24-27, 36 and 37 is/are rejected.
- 7) ☒ Claim(s) 9, 11-14 and 16-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to the amendment filed December 15, 2005.

Specification

1. The use of the trademark VELCRO® has been noted in this application. **It should be capitalized wherever it appears and be accompanied by the generic terminology.**

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

2. Claims 2, 4, 10, 15, 18, 20, 21, 25, 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the phrase "wherein the material is selected from the group comprising one of the following of fabric, cardboard, plastic, poster board, metal, and wood" is indefinite because it is unclear positively claiming each of the items fabric, cardboard, plastic, poster board, metal, or wood. The examiner suggest the use of the Markush phraseology: "wherein the material is selected from the group ***consisting*** of fabric, cardboard, plastic, poster board, metal, and wood". (See MPEP 1273.05(h) which explains the specific Markush phraseology).

Note similar language in claims 4, 15, 20, 21, 25, and 34-36.

Claim 10 and 25 contains the trademark/trade name VELCRO®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe *hook and loop fasteners* and, accordingly, the identification/description is indefinite.

The claims should be amendment to use "hook and loop fasteners" instead of "VELCRO".

Claim 18 is indefinite because the applicant does not claim structure to support the calendar's ability to become a countdown chart.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 7, 24-26, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Brooks, U. S. Patent 955,114. Brooks teaches a bookmarker comprising a narrow strip of resilient celluloid material having a calendar on one side and a

measuring rule on the reverse side. (lines 21-29). The examiner considers the measuring rule to correspond to the growth chart. It is inherent that a measuring rule can be any desired length.

With respect to claims 3 and 4, Brooks teaches a hook-like member or holder 2 for hanging the marker from the edge of a page of a book.

With respect to claim 6 and 25, Brooks teaches printing directly on the celluloid material or printing on a piece of paper and adhering the paper to the celluloid material.

With respect to claim 7, Brooks teaches an area below the rule area to accommodate addition indicia such as advertisement.

With respect to claim 18, the examiner considers the calendar to inherently correspond to the count down chart.

5. Claims 1, 2, 6, 7, 24-26, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodrich, U. S. Patent 365,916. Goodrich teaches a combined ruler and calendar comprising a thin strip of wood, rubber, or other materials **a** with a calendar **e** disposed on one side and ruler marking **f** printed on the opposite side. The examiner considers the measuring rule to correspond to the growth chart. It is inherent that a measuring rule can be any desired length.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 8, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodrich. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the combined calendar and ruler as long as desired to provide a means for measuring a larger area.

8. Claims 5, 8, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks. It would have been obvious to one having ordinary skill in the art at the time this invention was made to construct the combined calendar and ruler as long as desired to allow for measuring a larger area.

Allowable Subject Matter

Claims 10, 15, 28-35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 9, 11-14, 16-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed December 15, 2004 have been fully considered but they are not persuasive.

The applicant argues that prior art of record does not teach "a growth chart that has a height sufficient to measure the height of a person". The examiner contend that constructing the measuring rule of any suitable length is obvious depending on what object is to be measured. The rejection is maintained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cassandra Davis whose telephone number is 703-308-2223. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cassandra Davis
Primary Examiner
Art Unit 3611

CD
March 6, 2005